ESTABLISHING NOVELTY BY AFFIDAVITS

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Establishing Novelty by Affidavits.

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It is provided in Rule 76 that, when an application is rejected on reference to an expired or unexpired domestic patent which shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the Office, affidavits or depositions supporting or traversing these references or objections may be received. There are some other classes of cases in which affidavits may be received to establish novelty but this paper will be confined chiefly to the ones above mentioned.

When claims are rejected on facts within the knowledge of an employee of the office, if the applicant requests it, the employee must make an affidavit supporting the facts. The applicant may then submit affidavits to contradict, explain or antedate the facts recited in the affidavit of the employee. For example, the facts set up in the affidavit of the employee may not carry the anticipation back two years from the filing date of the application in which case applicant will be permitted, if he can do so, to overcome the anticipation by an affidavit similar to those which may be filed under Rule 75, thus establishing the novelty of his device.

The other three classes of references above referred to are domestic patents which show but do not claim the invention, foreign patents, and printed publications. These three classes of references are grouped together

and may be overcome by affidavits filed in accordance with the provisions of Rule 75.

Rule 75 provides that—

> "When an original or reissue application is rejected on reference to an expired or unexpired domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, and shall also make oath that he does not know and does not believe that the invention has been in public use or on sale in this country, or patented or described in a printed publication in this or any foreign country for more than two years prior to his application, and that he has never abandoned the invention, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than two years prior to the date on which application was filed in this country."

Briefly, the affidavit must state *facts* which show that applicant had invented his device prior to the date of the reference. What is the meaning of the word *facts* as used in this rule? A statement of applicant's own conclusions drawn from the facts within his knowledge without revealing those facts can not be accepted because that would not comply with the terms of the rule. The facts are required in order that it may be ascertained whether applicant's conclusions are warranted.

Suppose a case in which the state of facts is, that applicant had, before the date of the reference, fully evolved in his own mind the device disclosed in the application complete in every detail, one element, then another and so on until he had finally and fully conceived the combination of all the elements together in the completed machine, but that he had never described this to

any one or made any model or drawings thereof, or any other manner of record. This may be a true statement of facts which would seem to comply with the terms of the rule in every detail but he should not be granted a patent. He has furnished no proof, that is, no corroborating evidence to support his own statements. In short, he has furnished no proof except his own unsupported statements of prior conception of the invention.

In the first decision rendered on this subject, *ex parte* Gasser, C. D., 1880, page 94, the general principles were laid down as follows:

> "The applicant, therefore, must state on oath facts showing either that a reduction to practice had been made before the filing of the application on which the patent was granted, or that the invention had been conceived before that time and by due diligence connected with a subsequent reduction to practice."

The general principle here stated has been quoted with approval in almost every decision on this subject since that time, so that this seems to be the well-established practice up to the present time. While this indicates clearly in general formula what is required, the application thereof to specific cases as they arise is not entirely unattended with difficulty.

It is the intention here to discuss some of the specific cases which may arise and to indicate what conclusions it is believed should be drawn therefrom. In order to bring out the practical problems as they may be presented in actual experience the decision in the case of *ex parte* Donovan, C. D., 1890, page 109, seems to have gone into considerable detail and the following quoted therefrom will serve our purpose:

> "In *ex parte* Hunter (C. D., 1889, 218; 49 O. G., 733) it was stated that the rulings in *ex parte* Gasser and *ex parte* Saunders still governed the practice of the Office. Not only does the Office apply the principles laid down in *ex parte* Gasser in cases where it is sought to overcome a reference by an antedating oath, but it is difficult to see how in proceedings even *quasi* judicial, any

other course is permissible or even possible. It is the tribunal, which is to be satisfied that the applicant made the invention prior to the filing date of the reference. The witness states evidential facts which, when assembled, enable the Office to determine, first, whether the invention referred to in the affidavit was the same as that shown and described by the applicant, and, second, whether it was complete within the meaning of the rule before the filing date of the patent cited as a reference. To permit an applicant to prevail upon his naked statement that he conceived the invention and disclosed it to others, without stating by what agency the disclosure was made and the details of which it consisted, is to transfer the seat of judgment and decision from the tribunal sitting in the case to the mind of the applicant—a transaction radically defective in principle and contrary to all judicial usage. If the applicant made sketches, he should so state, and produce and describe them; if the sketches were made and lost, and their contents are remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made, the witness should state, as nearly as possible, the language used in imparting knowledge of the invention to others. By whatever means the applicant claims to have disclosed the invention he must so present those means to the examiner as to enable him to determine whether or not the invention was present in the disclosure. The mere naked statement of the applicant that he disclosed the invention is of no avail, either to constitute evidence of disclosure or to impart sufficiency to a statement of facts in themselves inadequate."

The inference from this decision is that in a case in which applicant has lost his sketches or models and their

contents are remembered he may present a transcript from his memory and that will be sufficient to overcome the reference. Of what more evidential value is it to furnish a mental reproduction of a drawing which one has made than to furnish a detailed mental reproduction of what was in one's mind, as in the case of the man who has made no record? Has the examiner any more evidence before him from the man who says I made a sketch and lost it, but here is a sketch of my recollection of what it was, than he has from the man who says I did not make a sketch at the time this device was worked out in my mind but here is a sketch of what I had in my mind at that time? Or, in the other case, when the affiant says, I stated in substance this description of my device to A, but he is now dead and I can not furnish his testimony or affidavit? The inference from the decision above quoted is that the examiner should say to the applicant in the one case, your story may be true but you have not made a record of it or told it to any one and therefore it can not be accepted as sufficient. Shall the examiner then say to the applicant in the other case, you admit that you have no evidence, but you say you have had and it is lost, or your witness is dead, and because you have been so unfortunate, you may have a patent on your own unsupported statement? It should be remembered that these affidavits are not specifically required by statute and the affiant stands in no danger of being prosecuted for perjury, this proceeding not being a judicial one. What would it avail a litigant to come before the court and say, I have had witnesses to corroborate my statements but they are now dead, therefore I hand you herewith my recollections of what they knew and could say if they were here.

It has frequently been said that Rule 75 is not statutory and should be abolished. If it is meant by this that the particular mode of proceedings therein prescribed is not statutory, it is true; and some other process for proving the same thing, that is, priority of invention and right to a patent under the statutes, may be substituted therefor. But, if it is meant that when applicant is confronted with a reference antedating his application less than two years he should not be permitted

any opportunity to show that he is entitled to a patent notwithstanding the reference, then the statement that the rule is not statutory seems to be erroneous.

Section 4886 of the Revised Statutes provides as follows:

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor."

Rule 75 constitutes the practice provided by the Patent Office for establishing certain rights which may accrue under the two-year clauses of this section of the statute. It appears that some adequate practice or process must be provided to carry out this section of the statute when conditions described in Rule 75 arise, because applicant may be able to appeal his case to the court and on a proper showing compel compliance with the statute and the grant of a patent.

In my view, the purpose underlying Rule 75 is not only proper but some such practice is necessary in order to carry out the provisions of the statute and give deserving inventors an opportunity to establish the novelty of their inventions by proper and convincing evidence. The great difficulty about the rule is that there is no opportunity to cross-examine the affiant and the case must rest on a *prima facie* showing.

The applicant who has competent evidence to offer, such as original sketches or drawings, or models, or depositions of others as to what he has disclosed to them, gives little difficulty, because he submits his proofs and would, probably, in a majority of cases, be only too glad

to submit to a cross-examination if opportunity were afforded. He should not be denied a patent because there is no provision in the practice for subjecting him to a rigid and searching inquiry. But the best of methods for securing justice may fail if they are not carefully and strictly enforced, and in these cases in which we can have no opportunity to search the mind of the affiant as to the accuracy of his statements it appears all the more important to require rigid compliance with the fundamentals prerequisite to a *prima facie* showing.

It is believed that excuses for not having corroborating evidence to substantiate an affidavit should never be accepted as sufficient. Such excuses, as the witnesses are dead or out of the jurisdiction and can not be found or the records are lost, but as I remember it here is what I could have proved, would not have the slightest standing in any court as a substitute for evidence. These excuses should only be accepted as a legitimate reason for introducing accurate and properly authenticated, that is, certified or clearly proven, copies of original records. For the examiner to accept these memory stories is to allow the applicant to establish his case by his own unsupported statements of what he has done.

While it might work a hardship to deprive one of a patent because he has been so unfortunate as to lose the evidence which would substantiate his case, it seems entirely unsafe for the Office to go beyond the pale of giving an applicant every opportunity to submit evidence to corroborate his statements. If any other course is followed it would appear to amount to nothing more than accepting an *ex parte* statement of conclusions of the applicant. To lower the standard of evidence to mere memory statements of the applicant is to open wide the door for fictions and fabrications.

It is true that a prima facie valid patent may be granted simply on a showing of facts. A preponderance of evidence, for example, is not required. It is not so much the quantity of evidence as the quality of it, that will constitute a prima facie showing sufficient to warrant the grant of a patent. The showing should be something that has evidential value in the sense of being corroborative of the statements contained in applicant's affidavit. It should be something independent of ap-

plicant's acts or statements during the time of the prosecution of his application, some record or disclosure he made, or some act he performed at the time alleged in his affidavit, which, if genuine or true, shows by its existence or occurrence the truth of his allegation.

It is submitted that the interests of the public and the inventors would be better served by requiring that an applicant to succeed under Rule 75 must furnish in addition to his own affidavit, corroborating evidence in the form of original drawings, sketches, models, or affidavits of other witnesses, or in other words, such competent and convincing evidence as would be admissible under the ordinary rules of evidence.

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